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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/712,943

11/13/2003

Gary Workman

00290P0021US

9536

32116

7590

02/28/2008

WOOD, PHILLIPS, KATZ, CLARK & MORTIMER

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SUITE 3800

CHICAGO, IL 60661

EXAMINER

DESAI, ANISH P

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

02/28/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Continuation of Box 11:**

1. The 35 USC Section 112-second paragraph rejections to claims 1-6 are maintained for the following reasons:

2. As stated previously in the Final Office Action, the recitation "unbonded capping testing system" is ambiguous. Applicant asserts that what is specified in claim 13 is irrelevant to claim 1. The Examiner respectfully submits that he is merely pointing to claim 13 to clarify his position as to ambiguity of the language in the preamble of claim 1. The language of claim 13 is clearer than the language of claim 1. Further, Applicant submits that Figure 1 shows unbonded capping system marked with a numeral 10. When one examines Figure 1, it is clear that the unbonded capping system 10 is a subset of a testing system for strength testing of concrete masonry units. The testing system further includes a test apparatus (Figure 1). Since the body of the claim 1 requires the presence of "a test apparatus", to the Examiner it is the testing system that includes a test apparatus, **not** the unbonded capping system. The unbonded capping system is a part of the overall testing system. Accordingly, the 35 USC Section-112 second paragraph rejections are maintained.

1. The language of claim 13 is clearer than the language of claim 1. Further, Applicant submits that Figure 1 shows unbonded capping system marked with a numeral 10.

When one examines Figure 1, it is clear that the unbonded capping system 10 is a subset of a testing system for strength testing of concrete masonry units. The testing system further includes a test apparatus (Figure 1). Since the body of the claim 1 requires the presence of "a test apparatus", to the Examiner it is the testing system that includes a test apparatus, **not** the unbonded capping system. The unbonded capping system is a part of the overall testing system. Accordingly, the 35 USC Section-112 second paragraph rejections are maintained.

3. With respect to the objected claims 7-18, please note that claims 7-12 include allowable subject matter over the prior art of record, however they are objected to as set forth in the previous Office Action. Applicant argues that it is not clear as to why there is any need to interpret claim 7 in view of the specification. According to Applicant he is entitled to claim the invention in as broad of terms as allowed by the prior art. The Examiner respectfully submits that while Applicant can claim invention in as broad of

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terms as allowed by the prior art and the specification, however claims must be interpreted against the specification for all that they are enabled. Further, it is the duty of the Examiner to look into the specification to determine the scope of the claims, which is done by examining what is enabled by the specification (MPEP 2111). When one looks into the specification, it becomes clear that the testing system of the claimed invention requires pistons to operate the platens. Further, this is the only way that Applicant's operates the platens. Additionally, this is the only manner the Examiner is aware of for these concrete testing apparatuses to function. This knowledge is based on the prior art of record. Therefore, given Applicant's teachings and the knowledge of one of ordinary skill in the art, the only interpretation of "in a testing system for compression testing of concrete masonry units" is to include platens and pistons into the device. This claim is a Jepson claim which inherently is referring to prior art. Determination of the scope of every limitation is integral part of a patent examiner's examination process. Accordingly, the claim objections are maintained.

/Terrel Morris/  
Terrel Morris  
Supervisory Patent Examiner  
Group Art Unit 1794